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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/069,220

02/22/2002

Isabelle Rollat-Corvol

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EXAMINER

CHANNAVAJALA, LAKSHMI SARADA

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/069,220

Applicant(s)

ROLLAT-CORVOL ET AL.

Examiner

Lakshmi S. Channavajjala

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2-7-05 has been entered.

Claims 1-9 are pending in the instant application.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11-14, 18-22 and 25-26 of copending Application No. 10/088,994. Although the conflicting claims are not

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identical, they are not patentably distinct from each other because the instant claims as well as the copending claims recite to a cosmetic composition comprising a genus of unpolymerized or relatively unpolymerized organosilicone compounds and a neutralizing agent. The cosmetic composition of the co-pending application recites specific organosilicone compounds that read on the compounds of instant dependent claims. While both sets of claims differ in the amounts of the organosilicone compounds and the neutralizing agent, choosing an optimum amount of silicone compound and the appropriate neutralizing agent with an expectation to achieve the desired cosmetic effect, in particular hair shaping or styling, would have been obvious for a skilled artisan because the composition of both applications are used for hair styling or shaping.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-9 are directed to an invention not patentably distinct from claims 11-14, 18-22, 25-26 of commonly assigned 10/088994. Specifically, instant claims are not distinct over the copending claims because the instant claimed genus is obvious over the claimed species of organosilicone compounds because the claimed specific compounds are also described and claimed in the instant dependent claims. Further, varying the amounts of organosilicone compounds and neutralizing the compounds with an appropriate (organic or inorganic acid) so as to solubilize the compounds would have been within the scope of a skilled artisan.

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The U.S. Patent and Trademark Office normally will not institute interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned 10/088994, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Claim Rejections - 35 USC § 103

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0159628 (EP 628) in view of US 5,707,434 to Halloran et al ('707).

EP 628 teaches hair-strengthening compositions containing alkyltrialkoxysilane compounds substituted with amino groups (pages 3-4). EP '628 teaches the presence

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of solvents such as ethanol, isopropanol (page 6) for stabilizing their composition containing silicone compounds. EP 628 fails to teach the neutralizing agent of the instant claims. However, EP recognizes that alkoxysilanes are stable for sometime but if allowed to stand for a prolonged period of time, excessive polymerization occurs resulting in premature precipitation of the silane, thus rendering the composition less effective for hair use (page 4).

Halloran teaches water-soluble ammonium siloxane compositions and their use for treating fibers. The composition of Halloran comprises a an amine siloxane comprising a mixture of triorganosilyl end blocked amino functional siloxane, an aminofunctional siloxane, which is triorgano-siloxy-end blocked at one end and hydroxy-end blocked at the other end; a cyclic amino functional group siloxane and an anion (col. 2-3). For the acid component, Halloran teaches both organic as well as inorganic acids (col. 7, col. Lines 27-54) that include the claimed sulfuric acid. Halloran teaches preparing water-soluble amino siloxanes by combining with acid and water and allowing the reaction of acid with the aminosiloxanes (col. 9, lines 20-43 and table 1). It would have been obvious for one of an ordinary skill in the art at the time of the instant invention to treat (neutralize) the aminosiloxanes compounds of EP 628 with inorganic acids such as sulfuric acid or organic acids taught by Halloran so as to render the silicone compounds of EP 628 water soluble because EP 628 desires a stable composition containing alkyloxysilanes that do not polymerize even before use and Halloran suggests that the water soluble siloxanes prepared by acid hydrolysis provides

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a composition that superior slickness upon application, without an oily feeling and yet a soft touch (col. 9).

Applicant's arguments (dated 11-29-04) with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 9.00 AM -6.30 PM

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lakshmi S Channavajjala
Examiner
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April 26, 2005